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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,980	12/30/2003	Jon C. Graff	042933/272520	8836
826 7590 01/10/2007 ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			EXAMINER WANG, HARRIS C	
			ART UNIT	PAPER NUMBER
			2112	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/748,980

Applicant(s)

GRAFF, JON C.

Examiner

Harris C. Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/19/2006, 12/30/2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, 7-9, and 12-15 teach providing certificates based on the "position" of the terminal. Due to the fact that the word "position" can both mean the rank of the terminal as well as the actual geographic location of the terminal, it is unclear what the Applicant is claiming.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 6-7, 12-15 and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6-7, 12-15 and 18 of copending Application No. 10749042. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3, 6-7, 12-15 and 18, the Applicant's claims are identical to the Reference's respective claims (10749042), with the exception of the Reference adding a tertiary CA which capable of providing at least one permission certificate to the terminal based on upon at least one characteristic of the terminal.

More specifically, the Applicant's Claim 1 teaches a terminal, a Primary CA that distributes Identity Certificates, a Secondary CA that distributes role certificates and a server that can authenticate the terminal based on the identity certificate and the role certificate. The Reference teaches a terminal, a Secondary CA that distributes role

certificates, a Tertiary CA that distributes permission certificates and a server that can authenticate the terminal based on an identity certificate, a role certificate and a permission certificate. Although the Reference does not explicitly teach a Primary CA, the Examiner interprets that there is inherently a Primary CA to produce the identity certificates for which the server must authenticate the terminal with.

Claim 7, teaches the method of using the system in Claim 1. Claim 13 teaches a terminal that is used in the system of Claim 1. The dependent claims of 1, 7 and 13 are all mapped out to the dependent claims of Application 10749042..

It would have been obvious to one of ordinary skill in the art at the time of the invention to remove the limitation of a tertiary CA , which produces permission certificates based on one characteristic, from the Reference to teach the Applicant's Claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-9, 12-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Juitt (US 2003/0087629).

Regarding Claim 1,

Juitt teaches a system comprising: a terminal capable of communicating at least one of within and across at least one network; wherein the terminal is included within an organization including a plurality of terminals, each terminal being at at least one of a plurality of positions within the organization; (*"The mobile device 100 can be any sort of device that has wireless communication capability, including...telephones" Paragraph [0037]*). The Examiner interprets the telephone as the terminal. The wireless telephone is shown as capable of communicating within and across at least one network as shown in Fig. 1 (Mobile Device 100 communicates with Wireless Network 105, where according to the background of the invention Juitt writes that "Wireless networks typically include mobile devices" Paragraph [0003]).

Juitt teaches a primary certification authority (CA) capable of providing an identity certificate to the terminal, wherein the primary CA is capable of issuing an identity certificate to each terminal of the organization. In Paragraph [0011] Juitt writes "the request [to access a protected network] might be an explicit request for access and can include an identifier and authentication information (e.g. a...digital certificate). The Examiner interprets a digital certificate that provides identifier information as an identity certificate. It is inherent that a CA is needed to distribute Identity Certificates.

Juitt teaches a secondary CA capable of providing at least one role certificate to the terminal based upon the at least one position of the terminal within the organization, wherein the organization includes a plurality of secondary CA's capable of issuing at least one role certificate to respective groups of terminals of the organization based upon the at least one position of each of the respective terminals within the organization. (*"In one embodiment, a role definer in the gateway server defines roles and assigns them to users. The role definer can specify network resources and degree of access to the protected network...Access privileges can be differentiated for authorized users based on roles."* [Paragraph [0020]]) The Examiner interprets the role assigner as the secondary CA capable of issuing role certificates based on the position of the respective terminals within the organization. The Examiner interprets "position" to mean rank or status. An example of Juitt assigning roles based on position is also found in Paragraph [0020] where "an 'engineer' role can be defined with full access to engineering department servers, but limited access to finance department servers."

Juitt teaches a server capable of authenticating the terminal based upon the identity certificate and the at least one role certificate of the terminal to thereby determine whether to grant the terminal access to at least one resource of the server. (*"Once the user is authenticated and assigned a role, an access controller in the gateway server provides access to the protected network based on the assigned role"* Paragraph [0021], Fig. 1A Authentication Server 125). The Examiner interprets the authentication process is done using an identity digital certificate as described above.

Regarding Claims 2 and 3

Juitt teaches a system according to claim 1, wherein the terminal comprises a terminal included within an organization comprising a customer base of a cellular service provider that includes a plurality of terminals, each terminal being at one of a plurality of positions comprising a plurality of service plans offered by the cellular network operator. (*"The wireless network 105 can support a wide variety of wireless networks, including cellular networks"* Paragraph [0038]) It is inherent that a cellular network will be used by a cellular service provider. It is inherent that cellular providers have service plans.

Regarding Claim 6,

Juitt teaches a system according to claim 1, wherein the terminal is capable of requesting access to at least one resource of a server before the server authenticates the terminal, and wherein the server is capable of granting access to the at least one resource if the terminal is authenticated. (*"The gateway server 120 authenticates the mobile device 100 utilizing its authentication subsystem 155, which may include authenticating the device or the user or owner of the device using an authentication server 125...the authentication server...determines whether the mobile device is authorized as well...thus the mobile device can be authorized to initiate a session with the protected network 110 via the wireless network 105 based on the access privilege information provided by the authentication server 125."*)

Paragraph [0056])

Regarding Claims 7-9 and 12

The method steps correspond to the system as described in Claims 1-3, 6.

Regarding Claims 13-18,

Juitt teaches a terminal included within an organization including a plurality of terminals, each terminal being at at least one of a plurality of positions within the organization, the terminal comprising: a controller capable of communicating at least one of within and across at least one network, wherein the controller is capable of obtaining an identity certificate from a primary certification authority (CA) capable of issuing an identity certificate to each terminal of the organization, wherein the controller

is also capable of obtaining at least one role certificate from a secondary CA based upon the at least one position of the terminal within the organization, wherein the organization includes a plurality of secondary CA's capable of issuing at least one role certificate to respective groups of terminals of the organization based upon the at least one position of each of the respective terminals within the organization;

and a memory capable of storing the identity certificate and at least one role certificate, wherein the controller is also capable of communicating with a server such that the server is capable of authenticating the terminal based upon the identity certificate and the at least one role certificate of the terminal to thereby determine whether to grant the terminal access to at least one resource of the server.

(Fig. 1 shows the Mobile Device 100, further described in Paragraph [0037] as a telephone that "has wireless capability" and the wireless network 105 described in Paragraph [0038] as a cellular network. It is inherent that a cellular phone will have a controller capable of receiving certificates ("digital certificate" Paragraph [0011]) and a controller capable of communicating with a server requesting access to resources (Fig. 1). It is inherent that the cellular phone will have a memory capable of storing digital certificates. It is inherent that if the network is a cellular network then there will be cellular service providers that are offering cellular service plans.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-5 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Juitt in view of the Technical Report Number 558 "A role and context based security model" by Yolanta Beresnevichiene pgs. 76-80 (Hereafter referred to as "the Technical Report")

Regarding Claim 4,

Juitt teaches a system according to claim 1, wherein the secondary CA is capable of providing at least one role certificate. Juitt does not teach having an associated validity time no greater than a validity time of the identity certificate provided by the primary CA.

The Technical Report teaches in Section 7.6.2 Life-Time (pg. 78) that "the validity of role certificates could be almost as long as of identity certificates."

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the system of Juitt with a role certificate with a shorter validity time than the identity certificate.

The motivation to combine is that a role may change more frequently whereas an identity should last longer. Therefore the role certificate should have a shorter validity time than an identity certificate.

Regarding Claim 5,

Juitt and the Technical Report teach a system according to claim 4. The combined references do not explicitly teach that the server is capable of authenticating the terminal based upon the validity times of the identity certificate and at least one role certificate of the respective terminal.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the authentication system described in Claim 4 to further include the limitation of validity time.

The motivation to modify is to provide an extra layer of access control.

Regarding Claims 10-11,

The method steps correspond to the system as described in Claims 4-5.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harris C. Wang whose telephone number is 5712701462. The examiner can normally be reached on M-F 7:30-5, Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 5712721497. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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HCW

A handwritten signature in black ink, appearing to read "Walter D. Griffin".

WALTER D. GRIFFIN
SUPERVISORY PATENT EXAMINER